

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

JUL 28 1999

) Decision on  
)  
) Petition for Regrade  
) Under 37 C.F.R. § 10.7(c)  
)  
In re \_\_\_\_\_ )

**MEMORANDUM AND ORDER**

(Petitioner) petitions for regrading his answers to questions 3, 4, 5, 6, 10, 22, 23, 26, 35, 36, and 37 of the afternoon section of the Registration Examination held on August 26, 1998. The petition is denied to the extent Petitioner seeks a passing grade on the afternoon section of the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 64 on the afternoon section. On January 5, 1999, Petitioner requested regrading of eleven two-point questions on the afternoon section, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

**OPINION**

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for

incorrect answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the afternoon section state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner’s arguments have been considered.

Question 3:

Two points are awarded for question 3.

Question 4 reads as follows:

4. Star Chemical Corporation retains you to obtain patent protection for their invention relating to improved production of ethylene oxide. You prepare and file a patent application in the PTO having a specification satisfying the requirements of 35 U.S.C. § 112 and the following two claims, which are fully supported by the specification:

1. A process for preparing a silver-supported catalyst for the improved production of ethylene oxide, said process comprising the steps of:

- (a) forming an aqueous solution of silver salt;
- (b) immersing completely in said solution a carrier of inert, porous particles, characterized by an average diameter not larger than 3/16 inch, an average pore diameter of 10 to 70 microns, and a surface area less than one square meter per gram;
- (c) impregnating said particles with said solution;
- (d) separating the impregnated particles from the remainder of said solution;
- (e) drying the separated particles, whereby said silver salt is deposited uniformly throughout the pores of said particles; and
- (f) activating the dried particles by heating them in air at a temperature sufficient to decompose the deposited silver salt.

2. An oxygen-activated catalyst for use in the controlled catalytic oxidation of ethylene to ethylene oxide, said catalyst comprising 5 to 25% by weight of silver, said silver being the thermal decomposition product of a pore solution-deposited silver salt uniformly distributed throughout the pores of inert, porous particles.

Claim 1 is rejected in the first Office Action under 35 U.S.C. § 103 as unpatentable over Able in view of Baker. Claim 2 is rejected under 35 U.S.C. § 103 as unpatentable over Baker. Able discloses a process for producing a catalyst for oxidation of ethylene to ethylene oxide by impregnating a porous carrier with a solution of a silver salt of an organic acid, separating the excess liquid, drying the impregnated carrier, and decomposing the silver salt by direct heat in an inert gas. Baker discloses a method of making an oxygen activated catalyst by coating a carrier with a silver catalyst using a paste or slurry. The silver compound paste is coated on the support, dried and then activated by treating the catalyst in large trays for several hours in a forced draft hot air oven at about 400°C. Baker discloses the physical characteristics of the oxygen-activated catalyst. The physical characteristics of the claimed catalyst are indistinguishable from Baker's catalyst.

Which of the following represents the best course of action to overcome the rejection and obtain a Notice of Allowance in the application?

- (A) Cancel Claim 1 and argue that the inventive catalyst has both a high selectivity, i.e., a measure of the ability of a catalyst to prefer the

partial oxidation reaction of ethylene over the total oxidation reaction of ethylene to carbon dioxide, and high productivity, i.e., a measure of the amount of ethylene oxide produced per unit of catalyst and per unit of time.

- (B) Cancel Claim 2 and argue that the combination of references is improper because it would not have been obvious to one of ordinary skill in the art to substitute the activation step of Baker for the activation step of Able.
- (C) Amend Claim 1 to recite that an oxidizing agent is added to the solution to prevent premature reduction of the silver salt.
- (D) Cancel Claim 1 and amend Claim 2 to recite that the inert, porous particles contain silica-alumina, and argue that such recitation is not disclosed by the references.
- (E) Cancel Claim 1 and argue that the combination of references is improper because it would not have been obvious to one of ordinary skill in the art to substitute the activation step of Baker for the activation step of Able.

Choice (B) is the most correct answer because cancellation of Claim 2 leaves only process Claim 1 which involves (i) impregnation of a carrier with a silver salt deposited from solution, and (ii) an activation step involving heating in air. While Able teaches step (i), his activation step involves heating in an inert gas, whereas Baker teaches step (ii), but his impregnation step involves impregnation of a carrier with a silver salt by coating the carrier with a paste or slurry. There is no suggestion in the references to arbitrarily select Able's step (i) and Baker's step (ii) and combine them to arrive at the inventive process. *In re Brown*, 459 F.2d 531, 534, 173 USPQ 685, 687 (CCPA 1972) (catalyst activation step using inert gas teaches away from combination with reference using air). Choice (B) overcomes the rejection of the product-by-process Claim 2.

Petitioner contends that “[i]n claim 1, step (e) there is no antecedent basis for ‘said silver salt.’” According to Petitioner, “[t]here is only antecedent basis for an ‘aqueous solution of silver salt.’” Petitioner maintains that “I believed that claim 1 was improper and must be canceled or amended to solve the antecedent problem.”

Petitioner's argument is not persuasive. Petitioner's argument that there is no antecedent basis for "said silver salt" is without merit. Antecedent basis for "said silver salt" appears in line 3 of Claim 1, i.e. "forming an aqueous solution of silver salt." Choice (D) is not the most correct answer because the product-by-process claim remains in the application. Since the patentability of such a claim does not depend on its method of production, and the product is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Brown*, 459 F.2d at 535, 173 USPQ at 688 ("[W]hen the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable"); *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) ("[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself"); MPEP § 2113. Thus, choice (D) is not the best strategy for overcoming the rejection. No error in grading has been shown. Petitioner's request for credit on Question 4 is denied.

Question 5:

Two points are awarded for question 5.

Question 6 reads as follows:

6. Egghead filed a patent application on subject matter pertaining to a method of producing a completely hardened metal structural element, such as a roller bearing race. The invention is directed to separating one bearing race from another in the production process. The specification discloses that the method consists essentially of the steps of (1) subjecting the surface of the element along an intended course of fracture to direct high energy radiation, such as a laser beam, to selectively embrittle the metal,

and (2) then splitting the element along the intended course of fracture, e.g., by a chilling process, such as quenching, or putting the surface subjected to radiation under tensile stress by applying a force to the structural element to generate the fracture, thereby forming separate bearing races. The specification does not include a definition of the language “completely hardened metal structural element,” and notes that the surface of the structural element may be provided with a groove along at least a portion of the intended course of the fracture, but that the groove is not provided to influence the course of the fracture, and hence, in contrast to known methods, it is unnecessary to form the groove as a sharp-edged notch.

In the course of prosecution, the examiner issued an Office Action rejecting claims 6 and 10, the remaining claims in the case, as anticipated by Highbrow under 35 U.S.C. § 102(b). The Highbrow patent teaches a method of producing a metal structural element by irradiating the surface of such element with high energy radiation along an intended course of fracture which has been provided with a sharp-edged notch, and then splitting the element along the intended course of fracture by quenching.

The claims are as follows:

6. A method of fracturing a completely hardened metal structural element, said method consisting essentially of subjecting the surface of the completely hardened structural element at least along a portion of an intended course of fracture and in transverse limitation thereto to a high energy radiation to selectively embrittle the metal, and then splitting the element along the intended course of fracture by a chilling process.

10. The method of Claim 6 comprising providing the surface of the completely hardened metal structural element along at least a portion of the intended course of fracture with a groove, and subjecting said element to said high energy radiation.

Which of the following actions should Egghead take that accords with proper PTO practice and procedure and stands the best chance of overcoming the examiner’s rejection?

- (A) Traverse the rejection and argue that Highbrow does not teach the application of “direct” high energy radiation as taught by Egghead.
- (B) Traverse the rejection and argue that the language “consisting essentially of” recited in Claim 6 excludes the “notching” step taught by Highbrow.

- (C) Amend Claim 6 by deleting the language “by a chilling process” at the end of the claim and traverse the rejection by arguing that Claim 6 no longer reads on Highbrow’s “quenching” step.
- (D) Traverse the rejection and argue that the language “a completely hardened metal structural element” recited in Claim 6 would be interpreted by one of ordinary skill in the art as defining a metal element which is completely crystalline throughout its structure and that the metal element disclosed by Highbrow does not possess this crystalline structure.
- (E) Amend Claim 6 by deleting the language “a chilling process” of the claim and, after “fracture by” in line 5, inserting the language “putting the surface subjected to radiation under tensile stress by applying a force to the structural element to generate the fracture.” Traverse the rejection on the ground that Highbrow does not teach this step and that his quenching step is not equivalent thereto.

Choice (E) is correct because the amendment in choice (E) introduces a step not taught by the reference. A rejection based on anticipation can only be maintained when the reference teaches every element of the claim. MPEP § 2131. Since the amendment to Claim 6 introduces a step not taught by the reference, the amended claim cannot be anticipated. Thus, choice (E) will overcome the examiner’s rejection.

The most correct answer is choice (E) and Petitioner selected choice (B). Petitioner contends that “Answer (B) is sufficient to meet the burden of MPEP sec. 2111.03.” According to Petitioner, “[w]hen arguing that the ‘notching step’ taught by Highbrow is excluded, this should be close enough to meet MPEP sec. 2111.03.” Petitioner maintains that “I did not think Answer (E) could be correct” because “Answer (E) has no antecedent basis for ‘structural element’ in the inserted language.”

Petitioner’s arguments are not persuasive. There are several reasons why choice (B) is a wrong answer. First, the argument in choice (B) that “‘consisting essentially of’ recited in Claim 6 excludes the ‘notching step’ taught by Highbrow” is inconsistent with the presence of “a groove” in dependent Claim 10. The argument in choice (B) does not

address this apparent inconsistency. Thus, choice (B) is based on an inconsistent claim interpretation and does not stand a good chance of overcoming the rejection. Second, the specification states that the “element may be provided with a groove.” The argument in choice (B) offers no basis for distinguishing the invention’s groove from the notch produced in the prior art and would be unlikely to overcome the rejection. Third, contrary to Petitioner’s view, more than argument is required to meet the burden of MPEP § 2111.03. “When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of ‘consisting essentially of,’ applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention.” MPEP § 2111.03. On facts similar to the facts in this question, the Board of Patent Appeals and Interferences rejected mere argument of the form presented by choice (B). *Ex parte Hoffman*, 12 USPQ2d 1061, 1064 (Bd. Pat. App. & Int. 1989) (“it is an applicant’s burden to establish that a step practiced in a prior art method is excluded from his claims by ‘consisting essentially of language”). The *Hoffman* case is quoted more extensively for the same proposition in MPEP § 2111.03. Given these facts, mere argument as proposed in choice (B) is unlikely to overcome the rejection. Petitioner argues that choice (E) cannot be in accord with proper PTO practice and procedure on the grounds that there is no antecedent basis for the phrase “structural element” in the amendment suggested by choice (E). However, claim lines 3 and 5 provide antecedent basis in the terms “structural element” and “element,” respectively. “[F]ailure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” MPEP 2173.05(e). In this

case, there is no ambiguity and Petitioner has provided no basis for establishing indefiniteness. Thus, the amendment suggested in choice (E) is in accord with proper PTO practice and procedure. The lack of identical antecedent basis terminology in line 5 is not a problem. No error in grading has been shown. Petitioner's request for credit on Question 6 is denied.

Question 10 reads as follows:

10. Applicant claims the following container lid combination:

1. A dispensing top for passing only several candy pieces at a time from an open ended container filled with candy, having a generally conical shape and an opening at each end, the opening at the reduced end allows several pieces of candy to pass through at the same time, and means at the enlarged end of the top embrace the open end of the container, the taper of the top being such that only a few pieces of candy are dispensed when the top is mounted on the container and the container is turned over.

The prior art reference X teaches a conically shaped funnel that can be secured on top of a can containing motor oil, such that the contents are dispensed when the can is turned on its side. X also mentions that it can be used for solid materials. The claim was rejected as anticipated by X under 35 U.S.C. 102. Which of the following replies to the rejection would be most likely to result in issuance of Claim 1?

- (A) Traversing the rejection on the ground that X is nonanalogous art, and therefore cannot be used for anticipation purposes against Claim 1.
- (B) Traversing the rejection on the ground that X does not specifically teach dispensing of candy pieces like Claim 1.
- (C) Amending Claim 1 to add specific limitations to the dimensions of the dispensing top.
- (D) All of the above.
- (E) None of the above.

Choice (C) is the most correct answer because amending the claim to add specific structural dimensions or other limitations is most likely to distinguish Claim 1 from prior art X. MPEP § 2114. Choice (E) is incorrect because an amendment such as proposed in

choice (C) is likely to overcome the rejection and result in issuance of the claim. Choice (A) is incorrect because analogous art is not a consideration for an anticipation rejection under 35 U.S.C. § 102. See *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (“the question whether a reference is analogous art is irrelevant to whether that reference anticipates”); MPEP § 2131.05. Choice (B) is incorrect because dispensing candy pieces as mentioned in Claim 1 is merely a functional description that does not structurally distinguish Claim 1 from X, which can be used to dispense liquids or solids. In *Schreiber*, claims directed to a funnel top for a popcorn dispenser were not successfully distinguished over a prior art oil funnel on the grounds that the claimed top was used for popcorn because the oil funnel inherently performs this function. *Schreiber*, 128 F.3d at 1479, 44 USPQ2d at 1433 (“declaration fails to show that [anticipating reference] inherently lacks the functionally defined limitations recited in claim”). Choice (D) is incorrect because choices (A) and (B) are incorrect.

The correct answer is choice (C) and Petitioner selected choice (E). Petitioner contends that “Answer (C) . . . is ambiguous” and that “[j]ust adding specific limitations to the dimensions is not enough.” According to Petitioner, “only specific limitations that distinguish the ‘claim 1’ top from the prior art top would result in the issuance of claim 1.” Petitioner “did not think that Answer (C) was detailed enough to overcome the rejection” and “believed that Answer (E) was the most correct answer.”

Petitioner’s arguments are not persuasive. The question asks for a comparison of the strategies proposed in choices (A), (B), and (C). Based on the facts provided in the question, amending Claim 1 to add specific limitations to the dimensions of the dispensing top is the most correct answer. That is, the strategies proposed by choices (A) and (B)

are less likely to result in issuance of the claim than the strategy in choice (C). MPEP § 2114 provides that “[e]ven if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference.” See also *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) (claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function). Petitioner’s argument that a change in dimension is not a change in structure is not persuasive. Adding specific limitations to the dimensions of the dispensing top differentiates Claim 1 from prior art X in terms of structure rather than function. The strategy in choice (C) is thus more likely to overcome the rejection and result in issuance of the claim than the strategy in either choice (A) or (B). Petitioner’s concerns with detail and specific dimensions are misplaced because they overstate the question asked. The question reduces to a decision on which of the three proposed strategies had the best likelihood of overcoming the rejection. No error in grading has been shown. Petitioner’s request for credit on Question 10 is denied.

Question 22 reads as follows:

22. Which of the following claims is (are) not in proper format?

- (A) A device for cooking small pieces of food comprising a basket including a mesh made of a material suitable for cooking small pieces of food, said mesh comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire device fits completely within conventional covered outdoor barbecue grills and such that the higher rear wall facilitates turning over the small pieces of food when the device is shaken.
- (B) A mesh basket for cooking food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the side walls are joined to the front and rear walls and the rear wall is higher than the front

wall such that the entire basket fits completely within conventional covered outdoor barbecue grills.

- (C) A device for grilling small pieces of food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall, and wherein the walls are made of a mesh material suitable for cooking or grilling small pieces of food.
- (D) (A) and (B).
- (E) None of the above.

The most correct answer is choice (E) because each of claims (A) – (C) is in proper format.

The correct answer is choice (E) and Petitioner selected choice (A). Petitioner contends that “all the claims in answers (A), (B), and (C) are indefinite because of the limitation directed to a ‘conventional outdoor barbecue.’” According to Petitioner, “[t]here is no size for the barbecue and therefore over the term of the patent the size of the ‘conventional outdoor barbecue’ will change, rendering the claim even more indefinite.” Since Petitioner “did not think any answer was correct [he] chose Answer (A) because it is indefinite and therefore not in proper format.”

Petitioner’s arguments are not persuasive. Petitioner’s arguments concerning definiteness are not germane to the call of the question which concerns “proper format” because definiteness is a substantive issue of compliance with 35 U.S.C. § 112, second paragraph. Petitioner’s argument concerning the size of a barbecue and the change in size over time does not establish indefiniteness. To establish that a claim is indefinite, it is necessary to establish that the claims do not reasonably apprise those skilled in the art both of the utilization and scope of the invention. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985). Petitioner fails to establish by evidence or reasoning that one of skill in the art cannot reasonably ascertain

the meaning of the term “conventional outdoor barbecue.” Petitioner’s concern with changing sizes over time is misplaced. It is well settled that future developments never contemplated by an inventor may be covered by patent claims. Further, the answer that follows from Petitioner’s reasoning is choice (D), not choice (A) as chosen by Petitioner. Petitioner’s argument is overly inclusive by grouping choice (C) with choices (A) and (B). Choice (C) does not include the phrase “conventional outdoor barbecue” that Petitioner considers indefinite. When Petitioner’s argument about indefiniteness is applied to the claims presented, only choices (A) and (B) could be indefinite. Thus, a choice consistent with Petitioner’s argument was available in answer (D) “(A) and (B),” but Petitioner inconsistently chose (A) alone. No error in grading has been shown. Petitioner’s request for credit on Question 22 is denied.

Question 23 reads as follows:

23. Which of the following statements is (are) true?

- (A) A claim may not be dependent on any claim which is itself a dependent claim.
- (B) A dependent claim may not contain means-plus-function limitations.
- (C) A dependent claim will always be infringed by any device that would also infringe the base claim from which it depends.
- (D) Any dependent claim may be re-drafted as an independent claim.
- (E) All of the above statements are true.

The most correct answer is choice (D) and Petitioner selected choice (B). The third paragraph of 35 U.S.C. § 112 states that “[a] claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” See also 37 CFR § 1.75(c). Thus, any dependent claim may be rewritten as an independent claim by expressly including all of the limitations of the base claim to which it referred. See MPEP § 608.01(n), page 600-63 (Claim Form and Arrangement). Choice

(B) is not correct because the sixth paragraph of 35 U.S.C. § 112 does not restrict means-plus-function language to independent claims.

Petitioner contends that “this question is ambiguous because Answer (A) could be true if each dependent claim referred to in the answer were a multiple dependent claim.” According to Petitioner, “[i]f both in Answer (A) were multiple dependent claims (which are dependent claims), the answer would be true.”

Petitioner’s argument is not persuasive. Petitioner’s position that “[i]f both in Answer (A) were multiple dependent claims” assumes facts not presented in the question in violation of the Examination Directions. There is no statement that the dependent claim referred to in the answer choices is a multiple dependent claim. Choice (A) is false because a dependent claim may depend upon another dependent claim so long as both are not multiple dependent claims. 35 U.S.C. § 112, third paragraph; 37 CFR § 1.75. See also MPEP § 608.01(n), page 600-63 (Rejection and Objection). Petitioner argues that choice (A) is true but selected choice (B) as a true statement. Choice (B) is false because 35 U.S.C. § 112, sixth paragraph, permits claim limitations to be written in means-plus-function format, and there is no prohibition on using this format in a dependent claim. Contrary to Petitioner’s position, the question is not ambiguous. No error in grading has been shown. Petitioner’s request for credit on Question 23 is denied.

Question 26 reads as follows:

26. The claim below is incomplete because it is missing limitation (iii).

A seating device comprising:

- (i) a base member having four parallel edges, and opposing first and second sides;

- (ii) a back member connected to one of the edges of the base member forming a right angle with said first side;
- (iii) \_\_\_\_\_;
- (iv) a pair of arm members connected to said back member and said first and second leg members, wherein said arm members are capable of supporting the arms of a person sitting in the seating device.

Of the following choices, which would be the best to complete the claim by providing the missing limitation (iii)?

- (A) a set of leg members connected to the second side of said base member;
- (B) a first pair of leg members connected to the second side of said base member at the same edge as the back member, and a second pair of leg members connected to the opposite edge of said support member;
- (C) first, second, third, and fourth leg members connected to said underside of said base member;
- (D) first, second, third, and fourth leg members connected to said second side of said base member, each edge having a leg member adjacent to said edge, wherein said leg members are parallel to each other;
- (E) first, second, third, and fourth leg members connected to said corners of said second side of said base member;

The most correct answer is choice (D) and Petitioner selected choice (B). Choice (D) would be the best choice to complete the claim because it provides antecedent basis for “said first and second leg members” referred to in limitation (iv). 35 U.S.C. § 112, second paragraph; MPEP § 2173.05(e). Choice (B) is incorrect because its recitations “a first pair of leg members” and “a second pair of leg members” fail to provide the necessary antecedent basis required by (iv) for “said first and second leg members.”

Petitioner contends that “Answer (B) is also correct if read under ‘Ex parte Porter,’ 25 U.S.P.Q. 2D (BNA) 1144.” Petitioner’s view is that the word “pair” could be dropped from choice (B). According to Petitioner, “I believe that if Answer (B) was used

as limitation (iii) of the claim, the scope of limitation (iv) would be reasonably ascertainable by those skilled in the art.” Petitioner reasons that “Answer (B) was at least as correct as Answer (D).”

Petitioner’s arguments are not persuasive. Choice (B) is incorrect because it does not recite “said first and second leg members.” Petitioner proposes to solve choice (B)’s failure to provide the needed antecedent basis by reading the word “pair” out of choice (B). Petitioner cites *Ex parte Porter* but does not explain its application to the facts here. In *Porter*, the Board found that “[t]he term ‘the controlled fluid’ . . . finds reasonable antecedent basis in the previously recited ‘controlled stream of fluid.’” 25 USPQ2d at 1146. Petitioner’s reliance on *Ex parte Porter* is misplaced. The question here is “which would be the best [choice] to complete the claim.” (Emphasis added). Choice (D) has no deficiency. Petitioner admits that choice (B) necessitates ignoring express terms to meet the needs of the claim. Thus, choice (B) is not as correct as choice (D) and cannot be the best answer. No error in grading has been shown. Petitioner’s request for credit on Question 26 is denied.

Question 35 reads as follows:

35. Given the following information regarding three claims:

- (i) A claim refers to “said lever” where the claim contains no earlier recitation or limitation of a lever;
- (ii) A claim initially refers to “an aluminum lever,” and “a plastic lever” and thereafter refers to “said lever”; and
- (iii) A claim initially refers to a “controlled stream of fluid” and thereafter refers to “the controlled fluid,”

which of the following statements is correct?

- (A) The claims (i), (ii) and (iii) are all definite.
- (B) The claims (i) and (ii) are definite; and the claim in (iii) is indefinite.
- (C) The claim (i) is indefinite; and the claims in (ii) and (iii) are definite.
- (D) The claims (i) and (ii) are indefinite; and the claim in (iii) is definite.
- (E) The claims in (i), (ii) and (iii) are all indefinite.

The most correct answer is choice (D) because the scope of (iii) is reasonably ascertainable by those skilled in the art, and neither (i) nor (ii) provides clear antecedent basis for “said lever.” See *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Int. 1992) (“controlled stream of fluid” provided reasonable antecedent basis for “the controlled fluid”). The question was constructed using three examples discussed in MPEP § 2173.05(e) “Lack of Antecedent Basis” for statements (i), (ii), and (iii).

The most correct answer is choice (D) and Petitioner selected choice (E). Petitioner contends that “(iii) is indefinite because of the location of the quotation marks.” According to Petitioner, “I believed that (iii) was indefinite because it did not refer to ‘a controlled stream of fluid’ but only ‘controlled stream of fluid.’” Petitioner maintains that “[s]ince I did not see the antecedent basis (the ‘a’) in the parenthesis in (iii), I believed it was indefinite and I chose Answer (E).”

Petitioner’s arguments are not persuasive. As provided in MPEP § 2173.05(e), “the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” Contrary to Petitioner’s argument, the Board’s decision in *Porter* does not require the article “a” and does not discuss the presence or absence of the article. Petitioner views *Porter* as imposing a requirement that is not there. Petitioner is referred again to the proposition relied on by MPEP § 2173.05(e) in its citation of *Porter*. The proposition, as stated in the MPEP, does not include the article

“a” in the critical phrase: “(‘controlled stream of fluid’ provided reasonable antecedent basis for ‘the controlled fluid’).” Petitioner shows no error in the MPEP reading because the principle stated by the Board requires that meaning be “reasonably ascertainable.” Petitioner has not shown that the presence or absence of the article “a” is pertinent here. No error in grading has been shown. Petitioner’s request for credit on Question 35 is denied.

Question 36 reads as follows:

36. Which of the following statements is true?

(i) An applicant cannot use a patent to prove the state of the art for the purpose of the enablement requirement if the patent has an issue date later than the effective filing date of the application.

(ii) A publication dated after the effective filing date of an application may be properly used to demonstrate that an application is nonenabling if the publication provides evidence of what one skilled in the art would have known on or before the application’s effective filing date.

(iii) The state of the art existing at the issue date of the patent is used to determine whether a particular disclosure in the patent is enabling.

- (A) (i), (ii) and (iii) are all true.
- (B) (i) and (ii) are true; (iii) is false.
- (C) (i) is false; (ii) and (iii) are true.
- (D) (i) is true; (ii) and (iii) are false.
- (E) (i), (ii) and (iii) are all false.

The most correct answer is choice (B). This question tests applicant’s knowledge of the principles discussed in MPEP § 2164.05(a) entitled “Specification Must Be Enabling as of the Filing Date.” Statement (i) is true because a later dated publication cannot be used to enable an earlier dated application. Statement (ii) is true since an examiner can look to later dated art if the art discloses the state of the art at the time of the invention. Statement (iii) is false since a patent disclosure must be enabling when filed.

Petitioner contends that choice (D) is correct because (ii) is false. According to Petitioner, “[t]he relative skill of those in the art refers to the skill of those in the art in relation to the subject matter to which the claimed invention pertains AT THE TIME THE APPLICATION WAS FILED.” Petitioner maintains that “[n]ot only is the filing date important, but also, so is the time the application is filed.”

Petitioner’s arguments are not persuasive. MPEP § 2164.05(a) states that “[i]n general, the examiner should not use post-filing date references to demonstrate that the patent is non-enabling. Exceptions to this rule could occur if a later-dated reference provides evidence of what one skilled in the art would have known on or before the effective filing date of the patent application.” See also *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513-14 (Fed. Cir. 1993); *In re Hogan*, 559 F.2d 595, 605, 194 USPQ 527, 537 (CCPA 1977). Accordingly, statement (ii) is true. No error in grading has been shown. Petitioner’s request for credit on Question 36 is denied.

Question 37 reads as follows:

37. Which of the following expressions, when found in a claim, comply with the provisions of the second paragraph of 35 U.S.C. § 112?

- (A) containing A, B, and optionally C . . . .
- (B) material such as rock, wool or asbestos . . . .
- (C) lighter hydrocarbons, such, for example, as the vapors or gas produced . . . .
- (D) normal operating conditions such as while in the container of a proportioner . . . .
- (E) such material as wood and the like . . . .

The most correct answer is choice (A). The word “optionally” may be used when there is no ambiguity as to which alternatives are covered by the claim. See MPEP § 2173.05(h), part III. Each of choices (B), (C), (D), and (E) are prima facie indefinite

because they set forth a broad term but mention a narrower range with the exemplary language “such as,” “such, for example, as” or “such . . . as.” The stated examples and preferences lead to confusion over the intended scope of the claim. It is not clear if the narrower range is a limitation of the broader term. See MPEP § 2173.05(d).

Accordingly, choices (B), (C), (D), and (E) fail to comply with 35 U.S.C. § 112, second paragraph.

The most correct answer is choice (A) and Petitioner selected choice (C).

Petitioner argues that “without additional information I could not determine if Answer (A) did comply with 35 U.S.C. § 112.” According to Petitioner, “I did not really think any of the answers would comply with the second paragraph of 35 U.S.C. 112 and I believe the question should be eliminated.” Petitioner maintains that “I chose answer (C) because I felt that none of the answers would comply with 35 U.S.C. sec. 112 because the answers are found in MPEP 2100, and therefore since they are all wrong I picked Answer (C) in order to fill in an answer.”

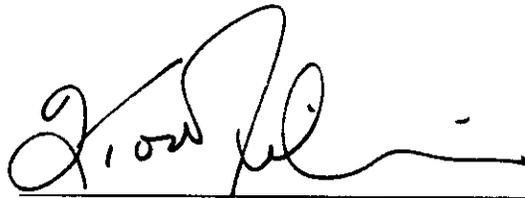
Petitioner’s arguments are not persuasive. Contrary to Petitioner’s position, additional information is not needed to determine that choice (A) is definite. There is no ambiguity as to which alternatives are covered by the claim because the claim covers two alternatives: the combination of elements A+B and the combination of elements A+B+C. No error in grading has been shown. Petitioner’s request for credit on Question 37 is denied.

**ORDER**

For the reasons given above, four points have been added to Petitioner's score in the Afternoon Section of the Examination. Therefore, Petitioner's score is adjusted to 68. This score is insufficient to pass the Afternoon Section of the Examination.

Upon consideration of the request for regrade to the Commissioner, it is ORDERED that the petition for a passing grade on the Afternoon Section of the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", written over a horizontal line.

Q. Todd Dickinson  
Acting Assistant Secretary of Commerce and  
Acting Commissioner of Patents and Trademarks